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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Reissue Application of:

Willibald KRAUS

Serial No.: 08/230,083

Group Art Unit: 2604

Filed: April 20, 1994

Examiner: H. Joyce

For: CHECK VALVE ASSEMBLY

Attorney Docket No.: TRW 2 0136-4

COPY OF PAPERS
ORIGINALLY FILEDAssistant Commissioner of Patents
Washington, D.C. 20231
Box APPEALS

TRANSMITTAL OF SUPPLEMENTAL APPEAL BRIEF

Dear Sir:

Enclosed is a Supplemental Appeal Brief for the above application.

It is believed that no additional fees are necessary at this time. However, if any fees are necessary, authorization is hereby granted to charge those fees against Deposit Account No. 06-0308.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **TRANSMITTAL OF SUPPLEMENTAL APPEAL BRIEF** is being deposited, in triplicate, with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, DC 20231, on April 26, 2002.

By: Barbara J. Whaley
Barbara J. Whaley

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SUPPLEMENTAL APPEAL BRIEF

This Supplemental Appeal Brief is filed in response to an Order mailed from the U.S. Patent and Trademark Office on February 28, 2002.

In that Order, the Board of Patent Appeals and Interferences (Board) cited 37 C.F.R. § 1.196(d) as authority for the Board requiring an appellant to address any matter that is deemed appropriate for reasoned decision on a pending appeal. That section further provides that the appellant will be given a non-extendable time period within which to respond to a requirement.

In the case at hand, the appellant was given a two (2) month time period within which to respond. Accordingly, the instant Supplemental Appeal Brief is due on April 28, 2002 and is considered to be timely filed.

Background

The sole issue on appeal is whether claims 14 and 16 have been properly rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The Appellant's Brief was filed on October 4, 2000 (Paper No. 35).

The case of Pannu v. Storz Instruments, Inc., 258

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F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), was decided on July 25, 2001.

In Pannu the Court in discussing the recapture rule stated that "[o]n reissue, [patentee] is estopped from attempting to recapture the precise limitation [patentee] added to overcome prior art rejections." 258 F.3d at 1372, 59 USQP2d at 1601.

The Order

Pursuant to 37 C.F.R. §1.196(d), the Board required appellant to file a Supplemental Appeal Brief to address the impact the Pannu decision has on the rejection presented before the Board in the instant appeal.

Brief Answer

The Pannu decision has no impact on the rejection before the Board in the instant appeal.

The Board cited discussions of the Court in the Pannu decision regarding the recapture rule indicating that on reissue, the patentee is estopped from attempting to recapture the precise limitation patentee added to overcome prior art rejections. However, in the case at hand, the appellant is not attempting to recapture any limitations previously added to overcome prior art rejections.

Essentially, in the application for the patent upon which the present reissue is based, many of the claims were allowed as filed. The allowed claims were simply converted into independent form to include the limitations of the base claim and their respective intervening claims. No limitations were added to the allowable dependent claims which were not already present in the claims as originally filed, based on inherency. Further, no limitations were added to the base claims themselves to overcome prior art rejections. The reissue claims 14 and 16 are substantially similar in scope to original application claim 1 was shown in Tables I and II attached below.

Accordingly, appellant respectfully submits that reissue claims 14 and 16 are allowable under the recapture doctrine. Allowance of all claims and early notice to that effect is respectfully requested.

Detailed Answer

The original application as filed on January 17, 1991 had fourteen (14) claims. Claims 2, 6, and 12-14 contained allowable subject matter as filed. More particularly, claims 2, 6, and 12-14 were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 12 were canceled by way of an amendment filed on September 10, 1991. Claims 15 and 16 were added by way of the amendment filed on September 10, 1991. Claim 15 was, essentially, allowable claim 2 rewritten into independent form to include the limitations of base claim 1. Claim 16 was, essentially, allowable claim 12 rewritten into independent form to include the limitations of base claim 1 and intervening claims 10 and 11. Original claim 1 was canceled by way of an Examiner's Amendment on November 8, 1991. The original application issued as U.S. Patent No. 5,105,731 on April 21, 1992. Original pending claims 3-11 and 13-16 were renumbered as claims 1-13 in U.S. Patent No. 5,105,731.

The instant reissue application was filed on April 20, 1994. The reissue application maintained claims 1-13 from the '731 patent and added new claims 14-16. Claim 15 was canceled by way of an amendment filed on August 15, 1995 in the reissue application.

The Pannu Decision

In Pannu, the plaintiff's reissue claim for an intraocular lens was held invalid on the ground of improper recapture of subject matter surrendered during prosecution

to avoid prior art rejections, since the reissue claim eliminated the limitation of the shape of the "haptics" element of the lens. The reissue claim was thus broader than the corresponding claim of the original patent. It was decided that this broadened aspect of the claim relates to surrendered subject matter in that the shape of the haptics was the same subject matter that was surrendered during prosecution of the original application, and since the recapture was not avoided by addition, on reissue, of limitations on the dimensions and positioning of the haptics element which do not narrow the claim in a manner directly pertinent to specific aspects that were narrowed during prosecution, namely, the shape of the haptics.

In 1980, Pannu filed a patent application for an artificial intraocular lens, S/N 136,243 ('243 application). The '243 application disclosed a round lens called an "optic" that focuses light on the retina, and two or more elements called "haptics" that are attached to the optic and contact internal tissue in the eye for the purpose of positioning and securing the optic. The haptics in Pannu's application included "snag resistant" discs at the end.

In 1981, Pannu filed a continuation-in-part application, S/N 261,953 ('953 application), based on the original '243 application. The '953 application added new matter, claiming a lens in which the haptics are "integrally molded" to the lens body, and the lens could be placed in either the anterior or posterior chamber of the eye.¹

Independent claim 1 of the '953 application reads as follows:

A posterior chamber intraocular lens comprising:
a lens having a width and a thickness;
a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;
and a snag resistant disc joined to the flexible strand's free end;
said snag resistant disc having a width which is at least 3 times greater than the thickness of the disc,

at least 3 times greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye;

said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

After substantive prosecution on the merits, rejected claim 1 was canceled and replaced with new claim 16. Claim 16 presented additional limitations to claim 1, the limitations significant to the purpose at hand being shown underlined. Independent claim 16 of the '953 application reads as follows:

An intraocular lens comprising:
a lens body;
at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;
said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.

After further substantive prosecution on the merits, claim 16 issued as claim 1 of U.S. Patent No. 4,435,855 ('855 patent) and reads as follows:

An intraocular lens comprising:
a lens body;
at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body;
said elements defining a continuous, substantially circular arc having a diameter rater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens, said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges

with said free end and is substantially greater in size than the width of said flexible elements.

In 1985, Pannu filed an application for reissue of the '855 patent. The supplement reissue oath stated that Pannu "unduly and without deceptive intent narrowed the claims beyond what was necessitated by the applied prior art by describing the shape of the outwardly extending elements as defining 'a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.'" The Examiner allowed Pannu to delete "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end" from claim 1.

However, the Examiner required Pannu to insert additional limitations into the last section of the claim. The last section of claim 1 reads as follows with underlining indicating additions and bracketing indicating deletions:

said snag resistant means having an uninterrupted, continuously smoothly curved outer periphery which merges with said free end and is [substantially] at least three times greater in [size] width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar.

As originally filed, none of the claims in the '953 application limited the shape of the haptic. Pannu filed a supplemental amendment canceling claim 1 and adding new independent claim 16. Claim 16 described the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." During prosecution, Pannu argued to the Examiner that "no such particular shape is disclosed by the lenses of either

Shearing or Lindstrom." The addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by Pannu to the Examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc.

In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he was estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.

Appellants Position Regarding Reissue Claim 14

Appellant is not removing limitations that caused claim 1 or any claims of the original application to be patented. Rather, as noted above, independent claim 1 of the original application was never itself patented or amended in any way to become patented. Instead, original claims 2 and 12-14 contained allowable subject matter as filed. The Examiner therefore merely objected to those claims in the Office Action mailed May 17, 1991, and indicated as those claims as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In response to the initial Office Action of May 17, 1991, appellant canceled original allowable claims 2 and 12 and rewrote them into independent form as new claims 15 and 16, respectively.

Essentially, appellant never amended independent claim 1 in the original application in order to secure allowance thereof. Rather, appellant merely canceled the rejected claims and rewrote the allowable claims into independent form to include all of the limitations of the base claim and any intervening claims.

In order to best help facilitate an analysis of claim 14 using the above guidelines, applicant has prepared Table I below illustrating the differences between original

application claim 1, patent claim 1, and reissue claim 14. As can be seen below in the Table, reissue claim 14 is broader than patent claim 1 in the "aspect" that the reissue claim 14 does not include the limitation of "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)". However, in order to determine whether an applicant surrendered particular subject matter, one must turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In the response to the first Office Action, without argument regarding the merits of the art of record, claim 1 was canceled and original application claim 2 was rewritten into independent form as new claim 15 to include all of the limitations of claim 2 and base claim 1 as filed. New claim 15 was essentially identical to allowable claim 2 as filed, without amendment. Accordingly, appellant does not admit to any surrendered subject matter in the instant Appeal.

One step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, appellant respectfully submits that the broader aspects of the reissue claim 14, namely the absence of the limitation of "wherein the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9" does not relate in any way to any subject matter that could fairly be considered to be "surrendered" during prosecution.

As noted above, no subject matter was surrendered since original application claim 2 included the rim, rib member and stay limitations.

No steps were taken by appellant to limit the claims of the original application to exclude a check valve assembly that did not include an inner frame, surrounding rim, rib members, and stays.

Appellant's Position Regarding Claim 16

Appellant is not removing limitations that caused claim 1 or any claims of the original application to be patented. Rather, as noted above, independent claim 1 of the original application was never itself patented or amended in any way to become patented. Instead, original claims 2 and 12-14 contained allowable subject matter as filed. The Examiner therefore merely objected to those claims in the Office Action mailed May 17, 1991, and indicated as those claims as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In response to the initial Office Action of May 17, 1991, appellant canceled original allowable claims 2 and 12 and rewrote them into independent form as new claims 15 and 16, respectively.

Essentially, appellant never amended independent claim 1 in the original application in order to secure allowance thereof. Rather, appellant merely canceled the rejected claims and rewrote the allowable claims into independent form to include all of the limitations of the base claim and any intervening claims.

In order to best help facilitate an analysis of claim 16 using the above guidelines applicant has prepared Table II below illustrating the differences between patent claim 11 and reissue claim 16. As can be seen below in the Table, reissue claim 16 is broader than patent claim 11 in the "aspect" that the reissue claim 16 does not include the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)". However, in order to determine whether an applicant surrendered particular subject matter, one must

turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In the response to the first Office Action, without argument regarding the merits of the art, claims 1 and 12 were canceled and original application claim 12 was rewritten into independent form as new claim 16 to include all of the limitations of base claim 1 and intervening claims 10 and 11 as filed. New claim 16 was essentially identical to allowable claim 12 as filed, without amendment. Accordingly, appellant does not admit to any surrendered subject matter in the instant Appeal.

One step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, appellant respectfully submits that the broader aspects of the reissue claim 16, namely the absence of the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" does not relate in any way to any subject matter that could fairly be considered to be "surrendered" during prosecution.

As noted above, no subject matter was surrendered since original application claim 12 included the dovetail guide limitation.

No steps were taken by appellant to limit the claims of the original application to exclude a check valve assembly that did not include a locking element guided over a dovetail guide on the outer surface of the outer housing.

TABLE I

Original Application Claim 1	Patent Claim 1	Reissue Claim 14
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	14. A <u>check valve assembly</u> adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which	an <u>outer housing</u> to which	an <u>outer housing</u> having an open end and a surrounding wall;
an <u>inner frame</u> is connected with	an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end;
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).	the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3); and,	first and second <u>resilient clip connections</u> joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle,
	wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9).	
		the first clip connection comprising a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

TABLE II

Original Application Claim 1	Patent Claim 11	Reissue Claim 16
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	11. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	16. A <u>check valve assembly</u> adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which	an <u>outer housing</u> to which	an <u>outer housing</u> having an open end;
an <u>inner frame</u> is connected with	an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).	a <u>resilient clip connection</u> (6) carried on the outer housing (3) and, wherein the clip connection (6) comprises a springy tongue (22')	a <u>resilient clip connection</u>
	<u>formed separate</u> from the outer housing (3), said springy tongue (22') being <u>arranged on a locking element</u> (30)	<u>formed separate</u> from the outer housing and <u>carried on a locking element</u>
	which can be <u>connected with the outer housing</u> (3), and	which is <u>connected with the outer housing</u>
	said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3).	
		the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

CONCLUSION

In view of the above comments and arguments presented, appellant respectfully submits that reissue claims 14 and 16 are allowable under the Recapture Doctrine and in view of the references of record.

Claims 1-13 stand allowed.

Allowance of all claims and early notice to that effect is respectfully requested.

Respectfully submitted,

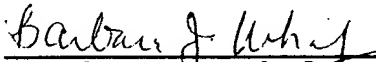
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CERTIFICATE OF MAILING

I hereby certify that this **SUPPLEMENTAL APPEAL BRIEF** is being deposited, in triplicate, with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231, on April 26, 2002.

By: 
Barbara J. Whaley

Date: 4-26-02